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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------|-------------|----------------------|---------------------|------------------|
| 09/839,893 | 04/20/2001 | Tony Valenzuela | PALM-3624 | 4291 |
| 7590 | 10/07/2003 | | EXAMINER | |
| WAGNER, MURABITO & HAO LLP | | | LE, UYEN CHAU N | |
| Third Floor | | | | |
| Two North Market Street | | | ART UNIT | PAPER NUMBER |
| San Jose, CA 95113 | | | 2876 | |

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/839,893 | VALENZUELA ET AL. | |
| | Examiner Uyen-Chau N. Le | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 August 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-12 and 16-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-12 and 16-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Requesting Continued Examination (RCE)

1. Receipt is acknowledged of the Requesting Continued Examination (RCE) and Amendment filed 18 August 2003.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-12 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeFrasne et al (US 5,603,629) in view of Tu (US 6,424,118).

Rc claims 1-12 and 16-21: DeFrasne et al discloses an apparatus/SIM card door for holding a SIM card 70 for an electronic device comprising a SIM card 70; a printed circuit board 20; a SIM connector 15 mounted on the printed circuit board 20; a SIM card door 22 for releasably holding the

SIM card 70, the SIM card door 22 is configured to move the SIM card 70 into engagement with the SIM connector 15 when in a closed position, to releasably hold the SIM card 70 such that the SIM card 70 is properly aligned with the SIM connector 15 when the SIM card door 22 is moved into the closed position, to slidably [slide tracks 4] accept the SIM card 70 into a properly aligned position when the SIM card door 22 is in the open position; a plurality of grooves [44, 50], which serves as holders disposed on the surface of the SIM card door 22, the grooves/holders [44, 50] configured to hold the SIM card 70 in the proper position, to hold the SIM card 70 when the SIM card door 22 is in the open position; the SIM card door 22 is releasably engageable with a housing and is including a latch in order to maintain the closed position and the housing is for containing an electronic device (e.g., a personal information device) (see figs. 1 and 3a; col. 2, line 15 through col. 44).

DeFrasne et al fails to teach or fairly suggest that the electronic device is a personal digital assistant and the printed circuit board is mounted within a housing of the personal digital assistant.

Tu teaches an apparatus for holding a SIM card 12 for a mobile phone 19, which serves as a personal digital assistant and the printed circuit board is mounted within a housing of the mobile phone 19 (see figs. 4 & 5).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tu into the teachings of DeFrasne et al in order to provide DeFrasne et al with a better protection of the printed circuit board (i.e., mounted within the housing). Furthermore, such modification would have been merely a substitution of equivalents (i.e., the electronic device is a personal digital assistant such as cellular phone, pagers, etc.) and an obvious engineering variation, well within the ordinary skill in the art, and therefore an obvious expedient.

Response to Arguments

5. Applicant's arguments filed 18 August 2003 have been fully considered but they are not persuasive.

6. In response to the Applicant's argument to "Tu does not show an apparatus for holding a SIM card.... Tu does not show a SIM card door in the housing ... wherein the SIM card door moves the SIM card into engagement with the SIM connector when in a closed position (p. 8, last paragraph), the examiner respectfully request the applicant to review Tu in fig. 4 and col. 2, lines 12-67), wherein the SIM card 12 is inserted into a SIM card door in the housing of the mobile phone, which serves as a PID, and the SIM card door moves the SIM card into engagement with the SIM connector 14 when in a closed position. Therefore, the apparatus for holding a SIM card for a mobile phone as taught by Tu meets the limitation of the claimed invention.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to DeFrasne et al discloses an apparatus/SIM card door for holding a SIM card 70 for an electronic device comprising a SIM card 70; a printed circuit board 20; a SIM connector 15 mounted on the printed circuit board 20; a SIM card door 22 for releasably holding the SIM card 70, the SIM card door 22 is configured to move the SIM card 70 into engagement with the SIM connector 15 when in a closed position. However, DeFrasne is silent with respect to the electronic device is a personal digital assistant and the printed circuit board is mounted within a housing of the

personal digital assistant. The secondary reference to Tu teaches this limitation. Accordingly, the claimed limitation, given the broadest reasonable interpretation, DeFrasne et al in view of Tu meets the limitation of the claimed invention (see the above rejection).

Conclusion

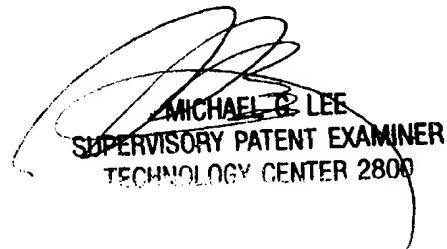
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Uyen-Chau N. Le

September 29, 2003



MICHAEL B. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800